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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

16356.605 (DC-02889)

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on Feb 24, 2006

Signature Susan C. Lien

Typed or printed name Susan C. Lien

Application Number

09/845,953

Filed

April 30, 2001

First Named Inventor

Liles, Terry Wayne et al

Art Unit

2192

Examiner

Yigdall, Michael J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

2 - 24 - 06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Docket No.: 16356.605 (DC-02889)
Customer No.: 000027683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Liles, Terry Wayne et al

Serial No. 09/845,953

Filed: April 30, 2001

For: METHOD, COMPUTER PROGRAM
PRODUCT, AND SYSTEM FOR
INSTALLING AN OPERATING
SYSTEM FROM A STORAGE DEVICE
USING A SECTOR OFFSET AND
APPARATUS FOR AUTOMATED
OPERATING SYSTEMS UPGRADE

§
§ Group Art Unit: 2192
§
§
§ Examiner: Yigdall, Michael J.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Final Office Action dated December 29, 2005, please consider the following remarks in connection with the pre-appeal brief request for review. Review of the final rejection is requested for the following reasons.

In The Final Rejection mailed on December 29, 2005, claims 1-3, 5-12, 14-21, and 23-28 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 6,681,323 to *Fontanesi et al* (*Fontanesi*) in view of U.S. Patent No. 6,351,850 to *van Gilluwe et al.* (*van Gilluwe*).

It is respectfully submitted that this §103 rejection is clearly not proper and is without basis. More specifically, as discussed below, the §103 rejection has a clear legal deficiency because it lacks an essential element to establish a *prima facie* rejection.

As the PTO recognizes in MPEP § 2142:

...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'

Independent claims 1, 10, 19 and 28 now include: ...configuring a memory to store a control process; in response to a size of a storage device, identifying a sector offset on the storage device; determining the sector offset by the control process prior to an operating system being installed on the computer system and prior to the storage device being partitioned; storing an image onto the storage device at the sector offset by copying the image from the memory to the storage device; providing the sector offset to an installation engine; and subsequent to storing the image on the storage device, initiating the installation engine to cause the operating system to be installed on the storage device using the image.

It is respectfully submitted that the Examiner cannot factually support a *prima facie* case of obviousness for the following mutually exclusive reasons.

The *Fontanesi* and *van Gilluwe* patents cannot be applied to reject claims 1, 10, 19 and 28 under 35 U.S.C. §103, which provides that:

A patent may not be obtained ... if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains... (Emphasis added).

Thus, when evaluating a claim to determine whether it is obvious, all limitations of the claim must be evaluated. However, the combination of the *Fontanesi* and *van Gilluwe* patents does not teach the following elements of amended independent claims 1, 10, 19 and 28: ...configuring a memory to store a control process; in response to a size of a storage device, identifying a sector offset on the storage device; determining the sector offset by the control

process prior to an operating system being installed on the computer system and prior to the storage device being partitioned; storing an image onto the storage device at the sector offset by copying the image from the memory to the storage device; providing the sector offset to an installation engine; and subsequent to storing the image on the storage device, initiating the installation engine to cause the operating system to be installed on the storage device using the image.

Because the combination of the *Fontanesi* and *van Gilluwe* patents does not teach all of the elements recited in amended independent claims 1, 10, 19 and 28, the rejection of these claims under obviousness is improper. Accordingly, it is respectfully requested that the rejections of claims 1, 10, 19, and 28 under 35 U.S.C. §103(a) be withdrawn. Moreover, dependent claims 2, 3, 5-9, 11, 12, 14-18, 20, 21, and 23-27 depend from and further limit the allowable subject matter claimed in the independent claims, and therefore are allowable as well.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO “failed to establish a *prima facie* case of obviousness”:

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had “reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious.” The court noted that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine

the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because neither *Fontanesi et al.* patent nor the *van Gilluwe et al.* patent teaches or even suggests the desirability of the combination. Moreover, neither patent provides any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Examiner recognizes the following shortcomings with respect to *Fontanesi*:

1. "Fontanesi does not expressly disclose ... in response to a size of a storage device, identifying a sector offset in the storage device."
2. "Fontanesi cannot store an image file on the storage device, as disclosed, without first identifying a location at which to store the image file."
3. "Likewise, Fontanesi cannot partition the storage device, as disclosed, without first identifying a location at which to do so."

Also, the Examiner recognizes the following shortcomings with respect to *van Gilluwe*:

1. "Although the identified location on the storage device is not expressly a sector offset, van Gilluwe discloses identifying the number of sectors and the number and location of each partition on the storage device."

The specification clearly states at page 5, lines 9 – 21, the following:

"To install operating system image 112 onto storage device 128 on computer system 120, control process 110 locates storage device 128 and identifies a sector offset on storage device 128 where control process 110 will cause operating system image 112 to be stored. As used herein, the term sector offset defines a physical location on a storage device, such as a storage device 128, without reference to a logical address associated with the storage device. The sector offset is determined by control process 110 prior to an operating system being installed on computer system 120. Accordingly, the sector offset is determined by control process 110 prior to storage device 128 being partitioned into one or more logical drives. In this way, the sector offset defines a physical location on storage device 128 without reference to a logical address. Control process 110 may determine the sector offset in conjunction with a basic input output system (BIOS) (not shown) on computer system 120. The BIOS may be configured to communicate with storage device 128."

To assemble the non-disclosures of both *Fontanesi* and *van Gilluwe* into a suggestion or modification to combine the references, to render the claimed invention obvious, is a requirement which is not met by the references.

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met. Accordingly, it is respectfully submitted that independent claims 1, 10, 19, and 28 and their dependent claims are allowable.

The *prima facie* case of obviousness is missing however, because the references fail to disclose each element of the claims or suggest the missing elements.

Other reasons for the patentability of claims 1-3, 5-12, 14-21 and 23-28 have been previously presented and will be maintained should the filing of an appeal brief become necessary.

Respectfully submitted,



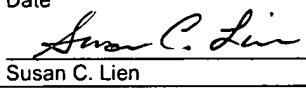
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on

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